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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,958	09/22/2003	Henry Drummond Boswell	CM2632MC	1197

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EXAMINER	
ELHILO, EISA B	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,958	BOSWELL ET AL.	
	Examiner	Art Unit	
	Eisa B Elhilo	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/22/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-14 are pending in this application.

DETAILED ACTION

1 Claim 2 objected to because of the following informalities: The claim recites the phrase "as described herein". This is improper claim terminology. Further, the measuring test in the above mentioned claim, is fully described in the specification, and therefore, the phrase "as described herein" should be deleted to make the claim in proper form. Appropriate correction is required.

Double Patenting

2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 12-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 9-22 and 26-30 of copending Application No. 10/667,878. Although the conflicting claims are not identical, they are not patentably distinct from each other because, Boswell, Application No. 10/667,878, teaches and discloses a similar hair treating composition comprising an oxidizing agent and a chelant (L) having a similar log ratio calculated at pH 10 of at least about 3.20 as claimed in claim 1, (see claims 1, 3 and 19-20 of the copending Application No. 10/667,878), wherein the

chelant has a hydrogen peroxide decomposition ratio of less than about 3.5% (between 0 and 3.5%) as claimed in claim 2 (see claims 4 and 21 of the copending Application No. 10/667,878), wherein the chelant forms a hexadendate complex with Cu+ as claimed in claim 3 (see claims 5 and 22 of the copending Application No. 10/667,878), wherein the pH of the composition is between 8 and 12 as claimed in claim 4 (see claim 9 of the copending Application No. 10/667,878),), wherein the composition is in the form of an oil-in-water emulsion as claimed in claim 5 (see claim 10 of the copending Application No. 10/667,878), wherein the composition is in the form of a thickened aqueous solution as claimed in claim 6 (see claim 11 of the copending Application No. 10/667,878), wherein the oxidizing agent is present at a level of from about 0.1% to 40% as claimed in claim 7 (see claims 12 and 26 of the copending Application No. 10/667,878), wherein the oxidizing agent comprises hydrogen peroxide as claimed in claim 8 (see claim 13 of the copending Application No. 10/667,878), wherein the chelant is present at a level of from about 0.01% to about 10% as claimed in claim 9 (see claim 14 of the copending Application No. 10/667,878), wherein the composition further comprises at least one oxidative hair dye as claimed in claim 10 (see claims 15 and 27 of the copending Application No. 10/667,878). Boswell, Application No. 10/667,878, also teaches similar methods of treating hair, wherein the methods comprise the steps of applying to the hair a first composition that comprises an oxidizing agent, a second composition that comprises a chelant agent and a third composition that comprises a second oxidizing agent as claimed in claim 12 (see claims 16 and 28 of the copending Application No. 10/667,878) and a method for dyeing hair comprising the steps of applying to the hair the mixture of oxidizing agent and an oxidative dye precursor for an amount of time and then rinsing off the composition with water as claimed in claim 14 (see claims 18

and 30 of the copending Application No. 10/667,878). Boswell, Application No. 10/667,878, further, teaches a kit for dyeing hair comprising a first composition that comprises an oxidizing agent and a second composition that comprises an oxidative agent as claimed in claim 13 (see claims 17 and 29 of the co-pending Application No. 10/667,878). Therefore, this is an obvious formulation.

Although, the claims of the copending Application No. 10/667,878, teach and disclose similar compositions for treating hair, they are not identical to the instant claims, because the claims of the copending Application No. 10/667,878, teach and disclose the damage benefit of the chelant agent in the composition, while the instant claims do not recite the damage benefit of the chelant in the composition. Further, the claims of the copending Application No. 10/667,878, teach similar methods for treating hair. Therefore, the conflicting claims are not identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in alternative, under 103(a) obvious over Dias et al. (US 6,004,355).

Dias et al. (US' 355) teaches a hair coloring composition comprising an oxidizing agent (see col. 3, line 3) and sequestrant (chelant) agents claimed in claim 1 (see col. 23, line 65), wherein the composition has a pH of 10, which is within the claimed range as claimed in claim 4 (see col. 32, line 65), wherein the composition is an aqueous solution as claimed in claim 6 (see col. 32, Examples I to VI), wherein the oxidizing agent comprises an aqueous hydrogen peroxide which is present in the amount of 0.1% to about 4%, which is within the claimed range as claimed in claims 7-8 (see col. 5, lines 45-64), wherein the chelant is present at a level of from about 0.01% to about 10% by weight of the composition as claimed in claim 9 (see col. 24, lines 7-9), wherein the composition further comprises an oxidative hair dye precursor as claimed in claim 10 (see col. 10, line 50). Dias et al. (US' 355), also teaches a kit comprising an oxidizing agent and one or more coloring agents as claimed in claim 13 (see col. 22, lines 65-67). Dias et al. (US' 355) teaches the same hair treating ingredients of oxidizing agents and a chelant compound of Glycinamide-N,N'-disuccinic acid (GADS) (monoamine monoamide -N,N'-dipolyacid) in the claimed amount, which inherently would have the same physical properties of log ratio as claimed in claim 1, hydrogen peroxide decomposition ratio as claimed in claim 2 and ability to form a hexadendate complex with Cu+ as claimed in claim 3. Dias et al. (US' 355) teaches all the limitations of the instant claims. Hence, Dias et al, anticipates the claims.

However, the claims in the alternative, under 35 U.S.C. 103(a) are obvious over Dias et al. (US' 355), because the reference teaches a hair dyeing composition comprising dyeing

ingredients of an oxidizing agent of hydrogen peroxide in the claimed amount (see col. 5, lines 45-63) and a chelant compound of Glycinamide-N,N'-disuccinic acid (GADS) (monoamine monoamide -N,N'-dipolyacid) in the claimed amount (see col. 24, lines 7-9 and line 50), because these are similar dyeing ingredients. Further, a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. (see *In re Spada, 911 F. 2d 705, 709, 15 USPQ2d 1655, 1658* (Fed. Cir. 1990), and, thus, a person of an ordinary skill in the art would expect such a dyeing composition to have ingredients having similar physical properties as those claimed including damage log ratio, hydrogen peroxide decomposition ratio values and ability to form a hexadendate complex with Cu+ as claimed. Absent unexpected results.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al. (US 6,004,355) in view of Wenke (US 5,100,436).

The disclosure of Dias et al. (US' 355), as described above, teaches hair treatment compositions in the form of hair coloring compositions (see col. 31, lines 62-64), wherein the compositions are thickened aqueous compositions (comprising thickeners and water) (see col. 32, Examples I to VI). The reference does not teach a hair treating composition in the form of an oil-in-water emulsion as claimed.

Wenke (US' 436) teaches in analogous art of oxidative hair formulation, a composition comprising primary intermediates (oxidative dye precursors) (see col. 9, lines 15-24), oxidizing agents such as hydrogen peroxide (see col. 10, line 58) and chelating agents (see col. 9, lines 36-37), wherein the composition is preferably liquid solution but may be in the form of emulsion, suspensions, lotions or gel. (see col. 9, lines 37-39).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to formulate the composition of the primary reference in a form of an emulsion (oil in water) as taught by Wenke (US' 436). Such modification would be obvious because the primary reference teaches an aqueous hair treating composition (see col. 32, Examples I to VI). The secondary reference of Wenke. (US' 436) clearly teaches different forms of the hair dyeing composition such as liquid solution, emulsion, suspensions, lotions or gel. (see col. 9, lines 37-39), and, thus, a person of an ordinary skill in the art would be motivated to formulate the dyeing composition of Dais et al. (US' 355) in any form including the claimed emulsion form, and, would expect such a composition to have similar properties to those claimed, absent unexpected results.

6 Claims 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al. (US 6,004,355).

Dias et al. (US' 355) teaches methods for coloring hair similar to the claimed methods, in that the reference's methods comprise the steps of applying to the hair an oxidative hair coloring composition that comprises hydrogen peroxide component (oxidizing agent), oxidation dye precursors and chelating agents as described above, wherein the methods comprise the step of applying to the hair the hydrogen peroxide component prior to application of the admixed

contents of the oxidative hair coloring agents and additional materials (see col. 34, lines 21-25), and wherein the methods also comprise the steps of mixing the oxidative hair coloring agents and oxidizing agent before application to the hair and the mixture is applied to the hair for periods of time depending upon the degree of coloring required (see col. 34, lines 6-7 and lines 30-34). Dias et al. (US' 355) further, teaches that the composition can be applied separately (see col. 34, line 8).

Although, Dias et al. (US' 355) teaches a method for treating hair comprising the steps of applying to the hair a composition that comprise oxidation dyeing precursors, oxidizing agents and chelant components as described above, the reference does not teach the steps of the claimed methods with sufficient specificity to constitute an anticipation of the claims.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use these methods for treating hair with a composition that comprises similar ingredients because the reference clearly teaches methods with different steps of applying the dyeing composition to the hair wherein the contents of the composition can be applied as a whole or separately as described above, and, thus, a person of an ordinary skill in the art would be motivated to utilize different methods for treating hair including the claimed methods and no matter which part of the composition is applied first, and would expect that these methods to have similar results to those claimed, in the absence of contrary.

Further, the applicants have not shown on record the criticality of the steps in the claimed methods.

Conclusion

7 The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eisa Elhilo
Patent Examiner
Art Unit 1751

July 9, 2004